

Notice of Allowability

Application No.

09/729,953

Examiner

John S. Chu

Applicant(s)

SATO ET AL.

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 1/19/07.
2. ☒ The allowed claim(s) is/are 6 and 7.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/023,801.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

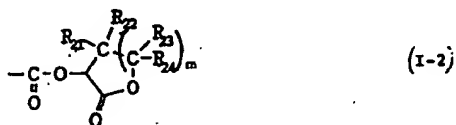
Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

REASONS FOR ALLOWANCE

1. The following is an examiner's statement of reasons for allowance: The claimed invention is drawn to the following;

6. (currently amended): A positive photoresist composition comprising a resin which has an ester group represented by the following general formula (I-2) in its molecule and is decomposed by action of an acid to increase solubility of the resin in an alkali solution, and a compound generating an acid by irradiation of an active light ray or radiation:

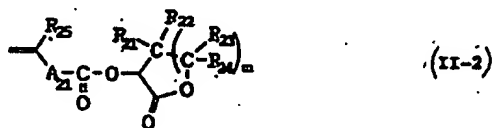


wherein R₂₁ to R₂₄, which may be the same or different, each represents a hydrogen atom or an alkyl group; and m represents 1 or 2;

wherein said resin further contains (1) repeating structure units each having an alicyclic hydrocarbon moiety and further contains (2) repeating structure units each having a group which is decomposed by action of an acid to increase solubility of the resin in an alkali developing solution.

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7. (previously presented): The positive photoresist composition according to claim 6, wherein said resin is a resin which contains repeating structure units corresponding to a monomer represented by the following general formula (II-2) and is decomposed by action of an acid to increase solubility of the resin in an alkali solution:



wherein R_{21} to R_{24} and m have the same meanings as given in claim 6; R_{25} represents a hydrogen atom or a methyl group; and A_{21} represents one group selected from the group consisting of a single bond, an alkylene group, a substituted alkylene group, an ether group, a thioether group, a carbonyl group, an ester group, an amido group, a sulfonamide group, a urethane group and a urea group, or a combination of two or more of them.

Applicants have compared the closest prior art composition to the claimed invention wherein Example 5 is seen to give an inferior sensitivity to the claimed inventive composition seen in Example 8 of the current specification. This comparison along with the declaration evidence received January 19, 2007 demonstrates the unexpected superior results of the claimed invention comprising the terpolymer over the prior art composition of Example 66 in NOZAKI et al. Thus the prima facie case of obviousness is overcome and claims 6 and 7 are seen as allowable and passed to issue.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

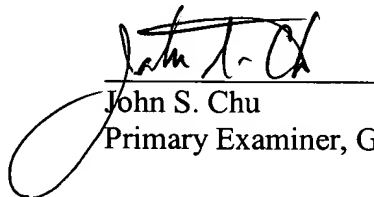
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2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (571) 272-1329. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Cynthia Kelly, can be reached on (571) 272-1526

The fax phone number for the USPTO is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John S. Chu
Primary Examiner, Group 1700

J.Chu
January 30, 2007